

REMARKS

Summary of the Office Action

In the Office Action, Claims 1-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese Patent No. 04-223875 (“JP’875”).

The Abstract, title, and claims 3, 4, and 8 were objected to for certain informalities.

Claims 1-9 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Summary of the Response to the Office Action

Applicant amends claims 1, 3-5, and 8-9 to better define the present invention and to address minor informalities. Applicant amends the Abstract and Title as suggested in the Office Action. Accordingly, claims 1-9 are pending and are submitted for further consideration. Applicant respectfully traverses these rejections and objections for the following reasons.

All Subject Matter Complies with 35 U.S.C. § 112, second paragraph

Claims 1-9 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. Claims 1, 3, 4, 5, 8, and 9 have been amended to correct the ambiguities alleged in the Office Action. Applicant respectfully submits that claims 1, 3, 4, 5, 8, and 9 are in full compliance with 35 U.S.C. § 112, second paragraph. Accordingly, it is respectfully requested that all rejections under 35 U.S.C. § 112, second paragraph, be withdrawn.

All Subject Matter Complies With 35 U.S.C. § 103(a)

Claims 1-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *JP'875*.

Applicant respectfully traverses the rejection under 35 U.S.C. § 103(a) for the following reasons.

JP'875 shows a grindstone with a singular curved surface for grinding a lens. The grindstone rotates an abrasion layer across the curved lens. See the Abstract of *JP'875*.

The Office Action states that “the skilled artisan would appreciate that grindstone and whetstones are similar as they both are used to mechanically deform an object. It would have been obvious to one skilled in the art to utilize the process of *JP'875* to produce a whetstone with the expectation of obtaining similar results.” Applicant agrees with the Examiner that the terms are similar and states that the term whetstone, as used in the specification, is intended to include the meaning of the term grindstone. However, Applicant respectfully submits that the above-mentioned reasons are not evidence of obviousness and hence the Office Action has not established a *prima facie* case of obviousness. As such, all rejections under 35 U.S.C. § 103(a) should be withdrawn.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations. All three criteria must be met to establish obviousness.

The Office Action has not established a *prima facie* case of obviousness at least because *JP'875* does not teach or suggest all the recited features of independent claim 1. Namely,

JP'875 does not teach or suggest at least “fixing plural base bodies on plural positions of a pedestal where at least one abrasive grain layer is formed,” features recited in claim 1. *JP'875* shows a grindstone with a singular curved surface for grinding a lens. Applicant respectfully submits that the Office Action does not address, teach, or suggest at least the “plural base bodies” features of the present invention, not shown in *JP'875*. See Fig. 1 and Abstract of *JP'875*.

As such, Applicant respectfully asserts that at least the third prong of *prima facie* obviousness has not been met. Accordingly, Applicant respectfully submits that independent claim 1 is allowable. Additionally, claims 2-9 are allowable at least because they recite the same combination of features as independent claim 1, as well as the additional features they recite that further distinguish them over the applied art. Accordingly, it is respectfully requested that all rejections under 35 U.S.C. § 103(a) be withdrawn.

CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicant's undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this Response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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